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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,005	07/02/2002	Gary Lord	VN29	5767

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,005

Applicant(s)

LORD ET AL.

Examiner

JYOTHSNA A VENKAT

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/28/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of IDS filed on 2/28/02. Claims 1-14 are pending in the application and the status of the application is as follows;

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 7, 9, 12 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is written description requirement.**

To satisfy the Written description requirement, applicant must convey with reasonable clarity to one skilled in the art, as of the filing date that applicant were in possession of the claimed invention. Applicant's claims are drawn to

1. A composition comprising:

1-25 wt. % of a silicone gum;

1-40 wt. % of a silicone fluid

1-35 wt. % of a silicone wax;

and 20-90 wt. % of a volatile silicone fluid and a method of forming film on a substrate comprising the above composition and the compositions and method also has “ **pharmaceutical agent** “ and “ **veterinary ingredient**”.

The specification does not define the compounds in these categories. The expressions “pharmaceutical agent” and “veterinary ingredient” without any description of the compounds does not convey to one of ordinary skill in the art that applicants were in possession of the claimed subject matter. Claims employing these two ingredients at the point of novelty, such as applicants’, neither provide those elements required to practice the inventions, nor “inform the public” during the life of the patent of the limits of the monopoly asserted. The expression could encompass myriad of compounds and applicants claimed expression *represents only an invitation to experiment regarding possible compounds.*

3. Claims 7, 9, 12 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The expressions “**pharmaceutical agent**” and “**veterinary ingredient**” are without metes and bounds. Recourse to the specification does not define these ingredients. These two ingredients are not additives but active ingredients. There is neither description nor exemplification. It is the examiners position that these expression lack clarity.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-8, and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of WO 97/17058('058) and U. S. Patent 5,496,544 ('544)

7. The instant application is claiming

1. *A composition comprising:*

1. *1-25 wt. % of a silicone gum;*

2. *1-40 wt. % of a silicone fluid*

3. *1-35 wt. % of a silicone wax;*

4. *and 20-90 wt. % of a volatile silicone fluid and a method of forming film on a substrate comprising the above composition and the compositions and method also has “ cosmetic ingredient “*

8. The WO document teaches transfer resistant cosmetic compositions using 1, 2 and 4.

See page 1 where the document teaches the compositions forms a film when applied to the substrate, which is skin. See page 9, lines 15-36 for silicone fluid, which is same as taught by the document as fluid diorganopolysiloxane polymers. See page 10, lines 9-25 for the ranges and volatile silicone oils, which is the claimed ingredient 4. See the examples at pages 18-28 for compositions with gum, See also all the examples for the ingredients 1, 2 and 4 claimed in the instant application. The document at page 12 teaches the use of skin care ingredients and

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pharmaceutical ingredients used in the compositions. The only difference is the document does not teach ingredient 3, which is silicone wax. The document suggests the use of waxes in the compositions. However, the patent '544 teaches cosmetic compositions using 1, 2 and 3. see col.2, and see col.3, lines 50 et seq and see col.4, lines 1-56. See also the examples.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '058 and combine it with the *silicone waxes* of '544, expecting beneficial effect to the skin. The motivation to use the silicone waxes stems from the teachings of '544 that the combination of all these ingredients provide better cosmetic properties than when used alone or combines with one or two ingredients together. The motivation to combine the ingredients flows logically from the art for having been used in the same field of endeavor. One of ordinary skill in the art would motivated to combine the ingredients with reasonable amount of success, because the combination of the ingredients benefit the consumer with enhanced cosmetic properties. This is a prima facie case of obviousness.


9. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Thursday, 9:30-7:30:1st and 2nd Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JYOTHSNA A VENKAT
Primary Examiner
Art Unit 1615
